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PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Case No. 00-387-P)

In re Application of:

Benkovic et al.

Serial No.: 10/615,703

Filing Date: July 9, 2003

For: Treatment of Bacterial Induced Diseases
Using DNA Methyl Transferase Inhibitors

Group Art Unit: 1623

Examiner: TBD

Mail Stop PETITIONS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL LETTER

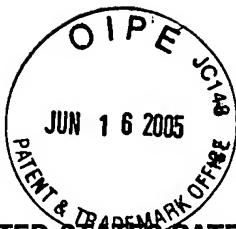
Sir:

In regard to the above-identified application:

1. We are transmitting herewith the attached
 - a. Request for Reconsideration of Petition under 37 C.F.R. §1.47(a) and Exhibits
2. With respect to additional fees:
 - a. An additional fee of \$130.00 is required.
3. Please charge any deficiency in the amount due, or credit any overpayment, to Deposit Account No. **13-2490**. A duplicate copy of this sheet is enclosed.
4. CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this Transmittal Letter and this paper, as described in paragraph 1 hereinabove, are being deposited with the United States Postal Service, with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22303-1450 on this 13th day of June 2005.

By:

Kevin E. Noonan, Ph.D.
Reg No. 35,303



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**REQUEST FOR RECONSIDERATION OF
PETITION UNDER 37 C.F.R. 1.47(a)**

Dear Sir:

Pursuant to 37 C.F.R. § 1.47(a) and the Decision on Petition, mailed April 11, 2005, Applicants respectfully request the Office to permit the signing inventors Dr. Stephen J. Benkovic ("Dr. Benkovic"), Dr. Lucy Shapiro ("Dr. Shapiro"), Dr. Craig Stephens ("Dr. Stephens"), Dr. Lyn Sue Kahng ("Dr. Kahng"), Dr. Anthony Berdis ("Dr. Berdis") and Dr. Irene Lee ("Dr. Lee"), to make application on behalf of themselves and co-inventor Dr. Rachel Wright ("Dr. Wright"), who cannot be reached despite diligent and persistent efforts to locate her.

In support of this Petition, Applicants submit herewith the Declaration of Kevin E. Noonan, Applicants' representative for the above-captioned application. Dr. Noonan attests in his declaration that the named inventors, including Dr. Wright, are also inventors of related applications, including priority International Patent Application Serial No. PCT/US97/16593, published March 26, 1998 having Publication No. WO 98/12206, and U.S. patent application Serial No. 09/269,137, which is a '371 national phase filing of PCT/US97/16593. Dr. Benkovic, Dr. Shapiro, Dr. Wright, Dr. Stephens, Dr. Kahng, Dr. Berdis and Dr. Lee also executed a Declaration for Patent Application for application 09/269,137, which issued as US Patent 6,413,751 on July 2, 2002.

Dr. Noonan attests that Dr. Wright executed an assignment and agreement for the invention to which application 09/269,137 is directed. In the executed assignment and agreement, Dr. Wright:

- a. sold, assigned and transferred to The Board of Trustees of the Leland Stanford Jr. University as assignee, and its successors, assigns and legal representatives, the entire right, title and interest, for all countries in and to certain inventions relating to DNA Adenine Methyltransferases and Uses Thereof described in an application for Letters Patent of the United States, filed as U.S. Serial No. 09/269,137 on 07/19/1999 and all the rights and privileges under any and all Letters Patent that may be granted therefore;
- b. requested that any and all patents for said inventions be issued to said assignee, its successors, assigns and legal representatives, or to such nominees as it may designate;
- c. agreed that, when requested, they will without charge to said assignee but at its expense, sign all papers, take all rightful oaths, and do all acts which may be necessary, desirable or convenient for securing and maintaining patents for said inventions in any and all countries and for vesting title thereto in said assignee, its successors, assigns and legal representatives or nominees; and
- d. authorized and empowered said assignee, its successors, assigns and legal representatives or nominees, to invoke and claim for any application for patent or other form of protection for said inventions filed by it or them, the benefit of the right of priority provided by the International Convention for the Protection of Industrial Property, as amended, or by any convention which may henceforth be substituted for it, and to invoke and claim such right of priority without further written or oral authorization from her.

This assignment and agreement was recorded on August 26, 1999 at reel/frame number 010195/0981.

In the instant application, to date only Dr. Benkovic, Dr. Shapiro, Dr. Stephens, Dr. Kahng, Dr. Berdis and Dr. Lee have executed and returned to MBHB a combined Declaration and Power of Attorney

for the present Application. Dr. Wright has not executed nor returned a copy of the combined Declaration and Power of Attorney document. Dr. Wright no longer works at Stanford University and never worked at Penn State University. The last known home address for Dr. Wright is 1022 Mallet Court, Menlo Park, CA 94025, which is the only address had by anyone associated with finding Dr. Wright. No current email or mailing address for Dr. Wright is known to the other inventors, their assignees or their representative, not to any of her former colleagues and associates who have been contacted.

Dr. Noonan further attests that a diligent effort was made to obtain a signed combined Declaration and Power of Attorney for the present Application from Dr. Wright. Facts previously submitted to the Patent and Trademark Office include the following. On May 7, 2004, Ms. Gwen Benoy, a paralegal at MBHB, sent Dr. Wright via United States Postal Service express mail to her last known home address a copy of the filing receipt for the present Application, and a combined Declaration and Power of Attorney. A cover letter with instructions and a request to execute and return the documents was included. These materials were returned to MBHB's offices on June 4, 2004 marked "unclaimed". On the receipt it is noted that delivery attempts were made on 5/8/04 and 5/10/04. In addition, Dr. Noonan avers that he had Ms. Benoy contact Dr. Shapiro, who is the head of the laboratory at Stanford where Dr. Wright did her post-doctoral work. Dr. Shapiro informed Ms. Benoy that Dr. Wright has moved back to her native country, New Zealand, and the Stanford laboratory did not have current address information for Dr. Wright.

Subsequent to the Decision on Petition mailed April 11, 2005, Dr. Noonan made further efforts to contact Dr. Wright. He avers that he had Ms. Rebecca Brown, a summer law clerk, conduct searches for Dr. Wright based on past associations with Stanford University and Pennsylvania State University; which proved fruitless. (Stanford University's website lists a reference to Dr. Wright as a fellow and recipient of a Stanford fellowship grant.) Dr. Noonan further avers that he had Ms. Brown run Google searches (www.google.com) for Dr. Wright along with various terms associated with her field of expertise and specialization. These searches yielded results from 1995, 1996 and 1998, representing scientific journal article publications. Most recently, Dr. Wright was mentioned in the acknowledgements of an article published in 1999 by Dr. Shapiro and others. Unfortunately, no references to Dr. Wright were found later than the acknowledgement in the 1999 article.

Ms. Brown telephoned Patricia Cook, the Director of the Stanford Graduate Fellowships Office Program where Dr. Wright completed a fellowship; she had no current information on Dr. Wright's whereabouts. Ms. Brown also spoke with Dr. Shapiro by telephone, but she had no information on Dr. Wright's whereabouts other than that she believed that Dr. Wright had moved back to New Zealand, and that her husband's name is Michael Croot.

All listings for Michael Croot in online telephone directories from New Zealand were no longer in service, and an international operator was unable to locate a listing for Michael Croot in any of the cities listed in the online directory. Ms. Brown also ran internet searches on Mr. Croot and was able to locate the subject matter of his doctoral thesis written in 1989 at the University of Otago, but no current contact information.

An online telephone directory search for "Rachel Wright" in the United States yielded 153 results, with 46 in California; Ms. Brown did not attempt to contact each of these listings. An online telephone directory search in all of New Zealand for "Rachel Wright" yielded one result, for Darren and Rachel Wright, in Christchurch. This number is no longer in service. A search in all of New Zealand for persons with the last name Wright yielded 2671 results. Ms. Brown did not attempt to contact each of these listings. Ms. Brown made contact with an operator in New Zealand and an international operator, both of whom told us that they were unable to run a nation-wide search for a Rachel Wright. A search for Rachel Wright in Christchurch yielded one listing for an R. Wright. This listing was not Dr. Wright's.

Ms. Brown generally searched (without result) United States sites for any mention of the death of Dr. Wright or her husband, Michael Croot. Additionally, Ms. Brown searched various New Zealand newspapers for an obituary notice for Dr. Wright or her husband, but found no relevant information.

Further, Dr. Noonan contacted an Australian patent associate, Ms. Linda Govenlock of Spruson & Ferguson, to seek suggestions for finding Dr. Wright. Ms. Govenlock responded by facsimile on June 3, 2005, stating that Spruson & Ferguson's records indicated that Dr. Wright was employed by Incyte Pharmaceuticals in Palo Alto, CA in 2000. Dr. Noonan contacted Incyte Pharmaceuticals, and was notified that the company had closed all west coast operations. He was also told that most of the employees of Incyte's west coast divisions were laid off, and that Dr. Wright was not among those employees that had relocated with the companies east coast locations. The company had no further contact information for Dr. Wright.

These are the efforts undertaken by Applicants or their representative in locating Dr. Wright. Applicants respectfully contend that these efforts were diligent, and that they have fulfilled the requirements of 37 C.F.R. §1.47(a).

Applicants submit herewith a combined Declaration and Power of Attorney shown in Exhibit F that includes an empty signature block for Dr. Wright. Applicants believe that this satisfies the requirement of 37 C.F.R. § 1.47(a) that all the available joint inventors must (1) make oath or declaration on their own behalf as required by 37 CFR §§ 1.63 or 1.175 and (2) make oath or declaration on behalf of the nonsigning joint inventor as required by 37 CFR § 1.64. See M.P.E.P § 409.03(a)(A), which states "An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated."

Applicants pray that their Petition is granted. Assignees Penn State Research Foundation and The Board of Trustees of Leland Stanford Jr. University will suffer irreparable harm if not allowed to apply for a patent for the above-listed Application because that the United States Patent and Trademark Office will otherwise hold the present Application abandoned without an executed Oath or Declaration.

Pursuant to 37 C.F.R. §§ 1.47(a) and 1.17(h), Applicants hereby authorize the United States Patent and Trademark Office to charge to account number 13-2490 the petition fee of \$130, and any other required fees.

Respectfully submitted

**McDONNELL BOEHNEN
HULBERT & BERGHOFF LLP**

Date: June 13th, 2005

By:

Kevin E. Noonan
Reg. No. 35,303